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10/663,477	09/15/2003	Peter Dam Nielsen	857.0017.U1(US)	2898

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EXAMINER
RADTKE, MARK A

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2165	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Interview Summary

	Application No.	Applicant(s)
Interview Summary	10/663,477	NIELSEN ET AL.
	Examiner	Art Unit	
	MARK A. X RADTKE	2165	

All participants (applicant, applicant's representative, PTO personnel):

(1) *MARK A. X RADTKE*.

(3) *Walter Malinowski (Applicant's Representative)*.

(2) *Christian Chace (SPE)*.

(4)_____.

Date of Interview: *20 February 2008*.

Type: a)☒ Telephonic   b)☐ Video Conference
       c)☐ Personal [copy given to: 1)☐ applicant   2)☐ applicant's representative]

Exhibit shown or demonstration conducted: d)☐ Yes   e)☒ No.
  If Yes, brief description: _____.
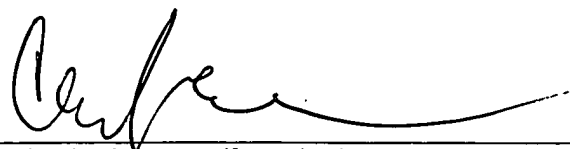
Claim(s) discussed: *1,15,16,18 and 19*.

Identification of prior art discussed: *Apfel (6,973,299) and McIntyre (7,111,317)*.

Agreement with respect to the claims f)☐ was reached.   g)☐ was not reached.   h)☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: *See Continuation Sheet*.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant presented proposed amendments and arguments. The interview began with Applicant's Representative asking for guidance on claim language. Examiner Radtke suggested expanding the final clause of claim 1 to describe the operation of the contact list. Examiners Radtke and Chace responded to Applicants arguments regarding intended use recitations and were unpersuaded. Applicant cannot assert that "arranged to" language is limiting while also asserting that the device is not necessarily performing the actions. Examiners suggested specific changes to claim one that would fix this problem (e.g., "a processor provides separately...", "wherein the database application accesses personal data..."). Applicant and Examiners then proceeded to discuss reasonable interpretations of the word "immediately".

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:

APPLICANTS: Peter Dam Nielsen

SERIAL NO.:   10/663,477   FILING DATE: September 15, 2003

EXAMINER: Radtke, Mark A.   ART UNIT: 2165

ATTORNEY'S DOCKET NO.:   857.0017.U1(US)

TITLE: MODIFYING A DATABASE COMPRISING IMAGE FIELDS

TELEPHONE INTERVIEW AGENDA

For telephone interview scheduled for 3:30 PM EDST, Tuesday, February 19 2008

Examiner Mark Radtke

Applicant's representative Walter Malinowski

Proposed amendment of independent and other claims.

Discussion of prior art starts on page 9.

PROPOSED AMENDMENTS TO THE CLAIMS:

This listing of the claims will replace all prior versions, and listings, of the claims in this application.

Please cancel claim 16 without prejudice.

Listing of Claims:

1. (Currently Amended)   An electronic device comprising:

a digital camera;

a user input device;

memory means storing computer program instructions; and

a processor operable under the control of the computer program instructions to provide separately a database application and a camera control application, wherein the database application is arranged to enable a user to access personal data organized as a plurality of entries in a database, where each of the plurality of entries is associated with a different person and has one or more alphanumeric text fields and an image field and wherein the camera control application is arranged to enable the user to control the electronic device using the user input device to capture an image via the digital camera and to immediately present a user selectable option, on capturing an image, for entering the database application and using the captured image as an image field of an entry of the database.

2. (Original)   An electronic device as claimed in claim 1, wherein the camera control application is arranged to immediately present a plurality of user-selectable options on capturing an image including an option for using the captured image as an image field of an entry of the database.

3. (Original)   An electronic device as claimed in claim 1, wherein the camera control application is arranged to transfer the captured image from storage in a first memory to permanent storage in the database.

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4. (Original)   An electronic device as claimed in claim 1, wherein the camera control application is arranged to control the creation of a new entry in the database.

5. (Original)   An electronic device as claimed in claim 1, wherein the camera control application is arranged to control the amendment of an existing entry in the database.

6. (Original)   An electronic device as claimed in claim 1, wherein the user input device enables a user to selectively use either the database application or the camera control application.

7. (Original)   An electronic device as claimed in claim 1, wherein the user input device is the keypad of a mobile telephone.

8. (Original)   An electronic device as claimed in claim 1, wherein the database application functions as at least a telephone book.

9. (Original)   An electronic device as claimed in claim 1, wherein each one of the plurality of database entries has at least one alphanumeric text field for storing a telephone number.

10. (Original) An electronic device as claimed in claim 9, operating as a telephone, further comprising a display, wherein the processor is responsive to an incoming call to display an image from the image field of a database entry that has an alphanumeric text field corresponding to the telephone number originating the incoming call.

11. (Original) An electronic device as claimed in claim 1, wherein an entry of the database can be selected by a user by scrolling the image fields of the database.

12. (Original) An electronic device as claimed in claim 2, wherein the processor is operable under the control of computer program instructions to provide an image viewing application, wherein selection of a first one of the plurality of user selectable options, makes the captured image accessible, via the database application, as an image field of a database entry and wherein

selection of a second one of the plurality of user selectable options makes the captured image available via the image viewing application.

13. (Original) An electronic device as claimed in claim 1 further comprising a temporary memory for temporarily storing a captured image.

14. (Original) An electronic device as claimed in claim 13, wherein the processor is operable under the control of computer program instructions to provide an image viewing application, and the camera control application is arranged to transfer the captured image from temporary storage in the temporary memory to permanent storage accessible by the viewing application.

15. (Currently Amended)   A method comprising:

    providing a first application that captures an image and, and upon capturing the image, immediately enables a user to enter a second application and assign the captured image to an image field of a first database entry ; and

    providing the second application for accessing the first database entry to display the image, wherein the method is arranged to modify a database that organizes personal data as a plurality of entries where each of the plurality of entries is associated with a different person and has one or more alphanumeric text fields and an image field.

16. (Canceled).

17. (Currently Amended)   A method as claimed in claim 15 16, wherein the first application immediately present a plurality of alternative user-selectable options on capturing an image including an option for assigning the captured image to an image field of a database entry.

18. (Currently Amended)   An electronic device comprising:

    message reception means;

    a user input device;

    memory means storing computer program instructions; and

a processor operable under the control of the computer program instructions to provide separately a database application and a messaging application, wherein the database application is arranged to enable a user to access personal data organized as a plurality of entries in a database, where each of the plurality of entries is associated with a different person and has one or more alphanumeric text fields and an image field and wherein the messaging application is arranged to display a received message including an image and to present a user selectable option for using the image as an image field of an entry of the database while within the messaging application.

19. (Previously Presented)   A method comprising:

providing a messaging application that receives an image in an incoming message and presents a user selectable option for using the image as an image field of an entry of a database; and

providing a database application for accessing the first database entry to display the image, wherein the method is arranged to modify the database that organizes personal data as a plurality of entries where each of the plurality of entries is associated with a different person and has one or more alphanumeric text fields and an image field while within the messaging application.

20. (Currently Amended)   A computer readable medium encoded with a computer program comprising:

program instructions for controlling an electronic device, the electronic device having a digital camera and a user input device, which program instructions when loaded into a processor, provide:

a database application; and

a camera control application that is separate from the database application,

wherein the database application is arranged to enable a user to access personal data organized as a plurality of entries in a database, where each of the plurality of entries is associated with a different person and has one or more alphanumeric text fields and an image field and wherein the camera control application is arranged to enable the user to control the electronic device using the user input device to capture an image via the digital camera and to

immediately present a user selectable option, on capturing an image, for entering the database application and using the captured image as an image field of an entry of the database.

21. (Canceled).

22. (Cancelled).

23. (Currently Amended)   A computer readable medium encoded with a computer program comprising:

program instructions for controlling an electronic device, the electronic device having message reception means and a user input device, which program instructions when loaded into a processor, provide:

a database application; and

a messaging application that is separate from the database application, wherein the database application is arranged to enable a user to access personal data organized as a plurality of entries in a database, where each of the plurality of entries is associated with a different person and has one or more alphanumeric text fields and an image field and wherein the messaging application is arranged to display a received message including an image and to present a user selectable option for using the image as an image field of an entry of the database while within the messaging application.

24. (Canceled).

25. (Cancelled).

REMARKS

Claims 1-15, 17-20, and 23 are currently pending. Claims 1, 15, and 20 have been amended with the subject matter of cancelled claim 16 and are also supported by page 6, lines 6-10 of the application as filed. Claims 18, 19, and 23 have been amended by the subject matter of page 7, lines 30-32, of the application as filed. Claim 17 has been amended to correct its dependency. Claim 16 has been cancelled without prejudice. It is respectfully submitted that no new matter has been added.

Initial Response to the Response to Arguments

The Patent Office on page 10 of the Final Office Action dated October 31 2007 asserted that phrases such as "arranged to enable," "to provide," "providing," and "operable ... to" are considered intended use because these phrases merely describe a capability of the claimed invention and are not positively recited. No case law was cited to support the Patent Office position Only MPEP section 2111.04 was cited for support by the Patent Office. MPEP Section 2111.04 recites as follows:

> Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:
>
> (A) "adapted to" or "adapted for" clauses;
>
> (B) "wherein" clauses; and
>
> (C) "whereby" clauses.
>
> The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l*

> *Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614,
> 1620 (Fed. Cir. 2003)) that a "'whereby clause in a method claim is not
> given weight when it simply expresses the intended result of a process
> step positively recited.'" *Id.*<

It is clear that MPEP Section 2111.04 is not making a blanket statement that a phrase such as "adapted to" is unacceptable. It merely states that one must consider the specific facts of the case.

In the present application, claim 1 recites "wherein the database application is arranged to enable a user to access personal data organized as a plurality of entries in a database." Although the phrase "arranged to" is not listed in the non-exhaustive list of phrases that raise questions regarding their limiting effect, the Patent Office contends that this phrase is one that is considered to be "intended use." It is important to consider the meaning of the claimed subject matter in its proper context. Here, we have a database application arranged to enable a user to access personal data. What is problematic with this? An application that is arranged to enable a user to access personal data is code or firmware that is established to perform one or more functions, such as permitting a user to access personal data. The claimed subject matter of "arranged to enable" is not intended use. It is not a case of whether the application can perform a function, because it can. What it means to recite language such as "arranged to" is that the application need not be running in order for a patent owner to be able to claim infringement.

The role of the Patent Office is to promote the useful arts. It does this by granting limited monopolies to exclude others from making or practicing an invention. In order to permit a patent owner to enforce his rights to exclude others, such as by pursuing infringers, enforceable claims need to be issued in a patent grant. The noted phrase, in a patent, would permit the patent owner to better pursue an infringer; for example, someone who is importing CDs or devices covered by the patent claims but for the CD or device being in operating to perform claimed functions and/or method steps.

The Patent Office asserts on page 10, lines 10-11, of the Final Office Action dated October 31 2007 as follows: "In effect, the claimed invention is a camera, an input device, memory and a processor." Applicant disagrees. As is known, a claimed invention is more than a

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laundry list of elements. Interrelationships between elements and functionalities of elements are also part of a claimed invention and help to provide proper meaning to the metes and bounds of the claimed invention. To prohibit a claimed invention from being given meaning for a function or interrelationship that exists but is only called into play at certain times runs counter to the spirit of invention and is contrary to the promotion of the useful arts.

Applicant believes that all phrases such as "arranged to" and "to provide" recited in the present claims cannot reasonably be considered "intended use."

Rejection of Claims 1-9, 12-21, 23, and 24 by Apfel in view of McIntyre

The Patent Office rejected claims 1-9, 12-21, 23, and 24 under 35 U.S.C. 103(a) as being unpatentable over Apfel, U.S. Patent No. 6,973,299, in view of McIntyre, U.S. Patent No. 7,111,317.

Claim 1 recites, in pertinent part, as follows

> An electronic device comprising: a digital camera; a user input device; memory means storing computer program instructions; and a processor operable under the control of the computer program instructions to provide separately a database application and a camera control application, wherein the database application is arranged to enable a user to access personal data organized as a plurality of entries in a database, where each of the plurality of entries is associated with a different person and has one or more alphanumeric text fields and an image field and wherein the camera control application is arranged to enable the user to control the electronic device using the user input device to capture an image via the digital camera and to immediately present a user selectable option, on capturing an image, for entering the database application and using the captured image as an image field of an entry of the database.

Claim 15 recites, in pertinent part, as follows:

> A method comprising: providing a first application that captures an image and, and upon capturing the image, immediately enables a user to enter a second application and assign the captured image to an image field of a first database entry; and providing the second application for accessing the first database entry to display the image, wherein the method is arranged to modify a database that organizes personal data as a plurality of entries where each of the plurality of entries is associated with a

different person and has one or more alphanumeric text fields and an image field.

Claim 20 recites, in pertinent part, as follows:

> A computer readable medium encoded with a computer program comprising: program instructions for controlling an electronic device, the electronic device having a digital camera and a user input device, which program instructions when loaded into a processor, provide: a database application; and a camera control application that is separate from the database application, wherein the database application is arranged to enable a user to access personal data organized as a plurality of entries in a database, where each of the plurality of entries is associated with a different person and has one or more alphanumeric text fields and an image field and wherein the camera control application is arranged to enable the user to control the electronic device using the user input device to capture an image via the digital camera and to immediately present a user selectable option, on capturing an image, for entering the database application and using the captured image as an image field of an entry of the database.

The Patent Office asserted from page 3, line 10, through page 4, line 6, of the Final Office Action dated October 31, 2007, as follows:

> Apfel does not explicitly teach a digital camera; and a camera control application arranged to enable the user to control the device using the user input device to capture an image via the digital camera and to present a user selectable option, on capturing an image, for entering the database application.
>
> McIntyre teaches an electronic device (see Abstract) comprising a digital camera (see column 3, line 38, "image capture device"); and a camera control application arranged to enable the user to control the electronic device using the user input device to capture an image via the digital camera and to present a user selectable option, on capturing an image, for entering the database application (see columns 12-13, spanning paragraph, particularly column 12, lines 61-62, "after taking a picture").
>
> Therefore, it would have been obvious to one of ordinary skill in the relevant art at the time the invention was made to have modified Apfel by the teaching of McIntyre because "[f]orms of communication for the one or more contacts include [...] multimedia message service (MMS)" (see Apfel, column 3, lines 52-55) and MMS messages are a well-known

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feature in camera phones. Furthermore, McIntyre anticipates the use of cellular phones at line 17 of column 22.

Apfel discloses a mobile phone that stores contact information for multiple forms of mobile phone communication with the contacts (abstract). In Apfel, user information 250B may include a picture or graphic that the contact wishes to publish to represent himself or herself (column 5, lines 53-56). Apfel discloses that changed contact information may include a new email address, phone number, picture representation, etc., for contact 230A at PC 270A (column 7, lines 51-53). Apfel's mobile phone, in Figure 3, is shown to have a display 310 and directional button 364 but clearly does not have an image capturing portion, such as a lens. Although picture representations may be changed in contact information for a mobile phone, Apfel does not disclose or suggest providing a user selectable option, upon capturing an image, to enter an application, such as a database application.

McIntyre discloses "A system and method for obtaining photographic products and/or services and for the sharing of digital images without the need of a computer. In particular a cable set top box and cable communication network is used for communication with third parties, including image service providers" (abstract). McIntyre discloses capturing an image and associating text with it. The image may be printed out at a later time with the text appear on the image. McIntyre does not disclose or suggest providing a user selectable option, upon capturing an image, to enter an application, such as a database application.

Furthermore, Apfel is concerned with updating a contacts list from a mobile telephone, whereas McIntyre is concerned with providing photographic goods and services (e.g., column 22, lines 5-8). Whereas Apfel discloses an image associated with a contact in a database, McIntyre is directed to the printing of images which may also contain text. It is difficult to see the relevancy of a method and system for providing image goods and/or services to a customer, as disclosed by McIntyre, to a method and system for providing a unified contact list for a mobile phone user, as disclosed by Apfel and it is doubtful that one of ordinary skill in the art would look to McIntyre to modify Apfel.

Thus, claims 1-9, 12-21, 23, and 24 are allowable over Apfel in view of McIntyre.

Claim 1 recites "An electronic device comprising: a digital camera." The Patent Office provides that the motivation to modify Apfel is found in Apfel, column 3, lines 52-55 because

"[f]orms of communication for the one or more contacts include [...] multimedia message service (MMS)." As Apfel has disclosed the source of any MMS images or pictures is the data service provider 210 (see column 5, lines 5-17) which communicates to a mobile phone 260 through the mobile phone carrier (Fig. 2), Apfel clearly does not teach a digital camera or even a camera and certainly does not show a camera or camera lens (see Fig. 3).

The Patent Office has not provided motivation for modifying Apfel by McIntyre to address the above noted subject matter from claim 1. Motivation surely cannot be based on the disclosure that Apfel may be able to receive MMS messages since such disclosure does not teach or suggest that the mobile phone which receives such messages also includes a camera.

For the sake of furthering prosecution, Applicant has further amended claim 1 to recite "wherein the camera control application is arranged to enable the user to control the electronic device using the user input device to capture an image via the digital camera and to **immediately** present a user selectable option, on capturing an image, for entering the database application and using the captured image as an image field of an entry of the database."

As such, the Patent Office has failed to make a prima facie case of obviousness based on Apfel modified by McIntyre for claim 1 and its dependent claims.

Regarding claim 15, Apfel does not disclose "a first application that captures an image and, and upon capturing the image, **immediately** enables a user to enter a second application and assign the captured image to an image field of a first database entry."

The Patent Office asserted that the paragraph spanning columns 12 and 13 in McIntyre discloses a camera control application that presents a user selectable option to enter a database application.

McIntyre does not teach or suggest the noted subject matter from claim 15. McIntyre, in the paragraph spanning from column 12, line 55, through column 13, line 3, discloses as follows:

> The configured firmware stored in the firmware memory 370 can include messages appropriate for various images, such as "Happy Birthday, John", or "Another Picture of the Smith family." These messages are provided by the customer in block 110 of FIG. 2, and downloaded to configure the APS film camera 350 in block 120 of FIG. 2. The message can be selected by the camera user after taking a picture, and can be then

> recorded as ASCII text data on the magnetic tracks of the APS film 380. When the APS film 380 is developed and printed, the magnetic tracks of the APS film 380 are read to recover this ASCII text message. The text message can then be printed on the back of the print if the print is made by optically printing the APS film 380. Alternatively, the text message can be printed on a front corner of the print if the print is made by scanning and digitally printing the APS film 380.

Looking at block 110 (or any other block) in Figure 2 does not show "a first application that captures an image and, and upon capturing the image, immediately enables a user to enter a second application and assign the captured image to an image field of a first database entry." Claim 15's well defined sequence of "a first application that captures an image" followed by "upon capturing the image, immediately enables a user to enter a second application and assign the captured image to an image field of a first database entry" is not found in the spanning paragraph or shown in Figure 2.

If the Patent Office persists in its position that McIntyre provides a teaching for the above noted subject matter from claim 15, Applicant requests that the Patent Office point out with particularity (such as by part number or column and line number) where the first application is disclosed, where the second application is disclosed, and where the interrelationship of the first application and the second application in which "upon capturing the image" that the first application captures, immediately enabling "a user to enter a second application and assign the captured image to an image field of a first database entry?" Despite the Patent Office's assertions, the subject matter from claim 15 does not appear to be in or suggested by McIntyre, certainly not where the Patent Office has asserted that it is supposed to be.

Barring such disclosure, claim 15 is allowable over Apfel in view of McIntyre.

Similar to claim 15, claim 20 recites "the camera control application is arranged to enable the user to control the electronic device using the user input device to capture an image via the digital camera and to **immediately** present a user selectable option, on capturing an image, for immediately entering the database application and using the captured image as an image field of an entry of the database."

For similar reasons as for claim 15, claim 20 is allowable over Apfel in view of McIntyre.

Claim 18 recites as follows:

An electronic device comprising: message reception means; a user input device; memory means storing computer program instructions; and a processor operable under the control of the computer program instructions to provide separately a database application and a messaging application, wherein the database application is arranged to enable a user to access personal data organized as a plurality of entries in a database, where each of the plurality of entries is associated with a different person and has one or more alphanumeric text fields and an image field and wherein the messaging application is arranged to display a received message including an image and to present a user selectable option for using the image as an image field of an entry of the database **while within the messaging application**.

Claim 19 recites as follows:

A method comprising: providing a messaging application that receives an image in an incoming message and presents a user selectable option for using the image as an image field of an entry of a database; and providing a database application for accessing the first database entry to display the image, wherein the method is arranged to modify the database that organizes personal data as a plurality of entries where each of the plurality of entries is associated with a different person and has one or more alphanumeric text fields and an image field **while within the messaging application**.

Claim 23 recites as follows:

A computer readable medium encoded with a computer program comprising: program instructions for controlling an electronic device, the electronic device having message reception means and a user input device, which program instructions when loaded into a processor, provide: a database application; and a messaging application that is separate from the database application, wherein the database application is arranged to enable a user to access personal data organized as a plurality of entries in a database, where each of the plurality of entries is associated with a different person and has one or more alphanumeric text fields and an image field and wherein the messaging application is arranged to display a received message including an image and to present a user selectable option for using the image as an image field of an entry of the database **while within the messaging application**.

Apfel discloses a unified contact list for a mobile phone user (abstract). Apfel's mobile phone 300 is shown to have the capability of sending mail 334 (Figure 3). "User information

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250B ... may include a picture or graphic that the contact publishes to represent himself or herself..." (Apfel, column 5, lines 53-56). Apfel discloses that a PC may update contact information including picture representation and provide the updated contact information to a mobile phone that includes that contact that has been updated (column 7, lines 45-61).

However, Apfel does not disclose presenting a user selectable option for using the image as an image field of an entry of the database while within the messaging application.

McIntyre discloses a system and method for obtaining photographic products and/or services and for sharing of digital images without the need of a computer (abstract). McIntyre discloses Figure 10 as a flow diagram of a typical purchase transaction in which a customer may select a service such as emailing images to one or more e-mail addresses provided by the user.

Like Apfel, McIntyre does not disclose presenting a user selectable option for using the image as an image field of an entry of the database while within the messaging application.

Thus, claims 18, 19, and 23 are allowable over Apfel in view of McIntyre.

Further Response to the Response to Arguments

As requested in the previous response to office action, Applicant requests that the Patent Office point out by line number and column number and by part number where the limitation of "present a user selectable option" is found.

Regarding the Patent Office assertion that "[a]ny processor is 'operable... to provide' any number of programs, and thus would anticipate the claimed invention." Applicant notes that the Patent Office is not considering each element of the claims. MPEP Section 2106 states "when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981)"

The Patent Office asserted, on page 3, lines 17-21, of the Final Office Action dated October 31 2007, that the limitation of a **"camera control application is arranged to enable**

the user to control the device using the user input device to capture an image via the digital
camera and to present a user selectable option, on capturing an image, for entering the
database application and using the captured image as an image field of an entry of the
database" is found in the paragraph spanning columns 12-13 in McIntyre. This paragraph of
McIntyre is reproduced immediately below:

> The configured firmware stored in the firmware memory 370 can include
> messages appropriate for various images, such as "Happy Birthday, John",
> or "Another Picture of the Smith family." These messages are provided by
> the customer in block 110 of FIG. 2, and downloaded to configure the
> APS film camera 350 in block 120 of FIG. 2. The message can be
> selected by the camera user after taking a picture, and can be then
> recorded as ASCII text data on the magnetic tracks of the APS film 380.
> When the APS film 380 is developed and printed, the magnetic tracks of
> the APS film 380 are read to recover this ASCII text message. The text
> message can then be printed on the back of the print if the print is made
> by optically printing the APS film 380. Alternatively, the text message
> can be printed on a front corner of the print if the print is made by
> scanning and digitally printing the APS film 380.

Applicant does not find the limitation of a user selectable option in this passage. The
phrase "present a user selectable option" is recited in the context of **"camera control
application is arranged to enable the user to control the device using the user input device
to capture an image via the digital camera and to immediately present a user selectable
option, on capturing an image, for entering the database application and using the
captured image as an image field of an entry of the database."** Applicant requests that the
Patent Office provide the column and line numbers and part numbers corresponding to a "camera
control application" arranged "to present a user selectable option, on capturing an image" in the
cited passage of McIntyre or elsewhere in Apfel or McIntyre.

Furthermore, in the cited passage of McIntyre (spanning columns 12 and 13), where is the
database and where is the disclosure of using the captured image as an image field of an entry of
the database?

McIntyre discloses a firmware memory 370 that can includes messages for various images
(column 12, lines 55-58). McIntyre discloses "The message can be selected by the camera user

after taking a picture, and can then be recorded as ASCII text data on the magnetic tracks of the APS film 380." McIntyre goes on to disclose that "when the APS film 380 is developed and printed, the magnetic tracks of the APS film are read to recover this ASCII text message" and that the text may be printed on the back of the print or on a front corner of a print.

How does McIntyre, in the passage spanning from column 12, line 55, through column 13, line 3, correspond to the recited subject matter of a **"camera control application is arranged to enable the user to control the device using the user input device to capture an image via the digital camera and to present a user selectable option, on capturing an image, for entering the database application and using the captured image as an image field of an entry of the database,"** recited in claim 1?

The Patent Office responded on page 10, lines 16-21, of the Final Office Action dated October 31, 2007, as follows:

> At line 61 of column 12, McIntyre discloses a user optionally recording text to a magnetic medium after taking a picture. The limitation requires that the user is presented with an option to enter the database after taking a picture. The recording of text is equivalent to entering the database because the data on the film is considered a database. "Entering a database has no special meaning in the art and recording data could be reasonably considered "entering." Thus, the claim limitations are met.

Claim 1 recites, in pertinent part, "the camera control application is arranged to enable the user to control the electronic device using the user input device to capture an image via the digital camera and to present a user selectable option, on capturing an image, for entering the database application and using the captured image as an image field of an entry of the database." The argument that "entering" a database has no special meaning in the art is contrary to the MPEP section 2106 which states "USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." Furthermore, any deficiency for "entering a database" is moot and incomplete, since the claim more actually recites "to immediately present a user selectable option, on capturing an image, for **entering the database application.**"

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Rejection of Claims 10 and 11 by Apfel in view of Morita

The Patent Office rejected claims 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over Apfel as applied to claims 9 and 1 above, respectively, and further in view of Morita, U.S. Patent No. 6,766,018.

The Patent Office asserted on page 3, lines 10-14, of the Final Office Action dated October 31, 2007, as follows:

> Apfel does not explicitly teach a digital camera; and a camera control application arranged to enable the user to control the device using the user input device to capture an image via the digital camera and to present a user selectable option, on capturing an image, for entering the database application.

The Patent Office's admitted deficiency of Apfel would apply to claims 10 and 11 as these two claims indirectly or directly depend from claim 1, which was rejected by a combination of Apfel and McIntyre.

The Patent Office has cited column 1, lines 38-40, of Morita with respect to claim 10 and column 1, lines 35-37, of Morita with respect to claim 11. Morita, column 1, lines 33-40, discloses as follows:

> Such a portable video telephone can also handle stored image information as information attached to the registered data in the phone book. At the time the phone book is searched for personal information, this capability can permit the user to conduct a search while viewing image information. When a call comes, this capability can display image information together with name information, helping the user understand immediately who the caller is.

Applicant requests that the Patent Office provide the column and line numbers and part numbers corresponding to a "camera control application" arranged "to immediately present a user selectable option, on capturing an image" in the cited passage of Morita or elsewhere in Apfel or Morita.

Since McIntyre is not relied upon in rejecting claims 10 and 11, where in Morita is a "user selectable option" presented? In Morita, where is the database and where is the disclosure of using the captured image as an image field of an entry of the database?

Morita appears to disclose replacing a displayed image by a currently decoded image that is acquired through a search result of a phone book and does not appear to disclose capturing an image or presenting a user selectable option, on capturing an image, for entering a database. Neither Apfel nor Morita appear to disclose or suggest "wherein the camera control application is arranged to enable the user to control the device using the user input device to capture an image via the digital camera and to present a user selectable option, on capturing an image, for entering the database application and using the captured image as an image field of an entry of the database." Claims 10 and 11 are patentable because their base claim, 1, is patentable and Morita does not remedy the deficiency of Apfel.

Thus, claims 10 and 11 are allowable over Apfel in view of Morita.

Regarding page 11, lines 1-5, of the Final Office Action dated October 31, 2007, Applicant notes that Apfel, the primary reference, discloses MMS but does not disclose or suggest a digital camera having a database application and a camera control application with the claimed functionality. No motivation has been provided to place a digital camera in Apfel.

The Patent Office is respectfully requested to reconsider and remove the rejections of the claims 1-21, 23, and 24 under 35 U.S.C. 103(a) based on Apfel in view of McIntyre or Morita, and to allow all of the pending claims 1-15, 17-20, and 23 as now presented for examination. An early notification of the allowability of claims 1-15, 17-20, and 23 is earnestly solicited.